

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
1654

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____Application Number
09/886,633Filed
June 21, 2001First Named Inventor
Mark YarkoskyArt Unit
2617Examiner
Bryan J. Fox

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Richard A. Machonkin/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Richard A. Machonkin

Typed or printed name

☒ attorney or agent of record.

Registration number 41,962

(312) 913-0001

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

September 11, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 1654)**

In re Application of:)	
)	
Yarkosky et al.)	Art Unit: 2617
)	
Serial No.: 09/886,633)	
)	Examiner: Bryan J. Fox
Filed: June 21, 2001)	
)	
For: Method And System For Overcoming)	Confirmation No. 6146
Pilot Polution In A Wireless)	
Communications Network)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Applicants request review of the final rejection mailed June 13, 2007, because the Examiner has clearly erred in rejecting the independent claims under § 102 and § 103.

1. The Claimed Invention

Applicants' claims are directed to methods and apparatus for forcing a hand-off within a cellular wireless system on crossing a boundary from a first geographical area to a second geographical area. To achieve this forced hand-off, the independent claims (claims 7, 11, 17, and 18) recite a directional antenna that transmits a boosted pilot signal within the second geographical area and substantially *only* along a boundary between the first and second geographical areas, as set forth below:

- Claim 7 recites “transmitting the boosted pilot signal within the second geographical area and substantially **only** along a boundary between the first and second geographical areas from a directional transmitting antenna”;
- Claim 11 recites “a directional transmission antenna that accepts the boosted pilot signal from the output of the radio-frequency amplifier and transmits the boosted pilot signal within the second geographical area and substantially **only** along a boundary between the first and second geographical areas”;
- Claim 17 recites “transmitting the boosted pilot signal within the second geographical area and substantially **only** along a boundary between the first and second geographical areas from the directional transmitting antenna”; and
- Claim 18 recites “a Yagi transmission antenna that accepts the boosted pilot signal from the output of the radio-frequency amplifier and transmits the boosted pilot signal within the second geographical area and substantially **only** along a boundary between the first and second geographical areas.”

2. Status of the Claims

Claims 7-14, 17, and 18 are currently pending. Claims 7, 8, and 11 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Kim et al., WO 01/31804 A1 (“Kim”). Claims 9, 10, 12-14, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in combination with other references.

3. The Examiner’s Clear Error

In rejecting claim 7, the Examiner argued that Kim discloses an apparatus for receiving and amplifying a pilot signal from a specified base station and transmitting it into an area where pilot pollution occurs. More particularly, the Examiner argued that Kim discloses “the signal is

transmitted into an area where a number of base stations co-exist” (citing to page 4, lines 7-13 and Figure 3) and that this disclosure reads on the claim element “transmitting the boosted pilot signal within the second geographical area and substantially only along a boundary between the first and second geographical areas from a directional transmitting antenna.” *See* Final Office Action, pp. 2-3. The Examiner made similar arguments in rejecting the other independent claims. *See* Final Office Action, p. 4 (for claim 11), p. 10 (for claim 17), p. 12 (for claim 18), and pp. 14-15 (all claims).

What the Examiner is referring to in these rejections is Kim’s disclosure of a relaying apparatus 380 that transmits a signal from a specified base station into a pilot pollution area 350. *See* Kim, page 4, lines 7-13. The pilot pollution area 350 is what the Examiner has called “an area where a number of base stations co-exist.”

However, this area is not substantially **only** along a boundary between first and second geographical coverage areas. Figure 3 of Kim shows that pilot pollution area 350 includes **multiple** boundaries, namely: (i) the overlap of areas 310 and 320, (ii) the overlap of areas 320 and 330, (iii) the overlap of areas 330 and 340, (iv) the overlap of areas 340 and 310, and (v) the overlap of areas 340 and 320. Thus, this “area where a number of base stations co-exist” (pilot pollution area 350) into which the signal from relaying apparatus 380 is transmitted is not substantially **only** along a boundary between first and second geographical coverage areas, as recited in independent claims 7, 11, 17, and 18. To the contrary, this area encompasses **many** boundaries.

The Examiner has nonetheless argued that “wherein the area where multiple base stations exist reads on the ‘substantially only along the boundary.’” *See* Final Office Action, pp. 14-15. As an initial matter, the Examiner has used the “read on” test incorrectly. Anticipation requires

the *claim* to read on the *reference*, not the reverse as the Examiner has stated. *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999)(“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.”).

When the correct test is applied, it is clear that transmitting substantially *only* along a boundary between first and second coverage areas, as recited in the claims, does not read on transmitting into an area that encompasses *multiple* boundaries between coverage areas, as disclosed in Kim. For example, transmitting substantially *only* along the boundary between the United States and Canada is not the same as transmitting along both the U.S./Canada and U.S./Mexico borders. To hold otherwise, as the Examiner has, would improperly ignore the term “only” in the claims. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *See* MPEP § 2143.03.

Because Kim does not disclose transmitting a signal substantially *only* along a boundary between first and second geographical coverage areas, the Examiner’s claim rejections are clearly erroneous.

4. Conclusion

For the foregoing reasons, Applicants submit that all of the pending claims should be allowed.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: September 11, 2007

By: /Richard A. Machonkin/
Richard A. Machonkin
Reg. No. 41,962